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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,326	02/20/2004	Michael J. Czaplicki	1001-133	6882

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/783,326	CZAPLICKI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert Sellers	1712	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/21/2004</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a material comprising an epoxy/elastomer adduct, an epoxy resin and a curing agent, classified in class 525, subclass 526.
- II. Claims 10-19, drawn to an epoxy/elastomer adduct, classified in class 525, subclass 119.
- III. Claims 20-23, drawn to a method of forming an epoxy/elastomer adduct, classified in class 525, subclass 120.

The inventions are distinct from each other because of the following reasons:

2. Inventions II and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as an impact modifier and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

3. Inventions III and (I or II) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another materially different product or (2) the product as claimed can be made by another materially different process (MPEP § 806.05(f)). In the instant case, process as claimed can be used to make another materially different product such as the reaction of a hydroxyl-terminated elastomer with an isocyanate-terminated polyurethane prepolymer.

Restriction for examination purposes as indicated is proper because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification.

4. This application contains claims directed to the following patentably distinct species:

a) The epoxies of the epoxy/elastomer adduct. Tables A and B on page 5 of the specification employ KER 1001 solid epoxy resin. However, the chemical name and/or structure of such a species must be identified for a proper election.

b) The elastomers of the epoxy/elastomer adduct. Tables A and B utilize a carboxylated nitrile-butadiene rubber.

c) Contingent upon the election of Group I, items a) and b) hereinabove and

i) The epoxy resins. The table on page 13 uses a standard liquid epoxy resin. However, the chemical name and/or structure thereof must be revealed to satisfy the requirement.

ii) The curing agents such as either dicyandiamide, 4,4'-methylene bis(phenyldimethylurea), or a mixture thereof as exhibited in the table on page 13.

iii) The presence or absence of the calcium carbonate filler of claim 2.

iv) The presence or absence of the azodicarbonamide blowing agent of claim 2.

v) The material with or without the catalyst of claims 4, 5, 11 or 12, wherein if its presence is elected, a particular species thereof is identified from triphenyl phosphine or ethyl triphenyl phosphonium bromide.

vi) The materials with or without the reactive diluent of claim 9, wherein if its presence is elected, a particular species thereof is designated such as either the phenyl glycidyl ether or cresol glycidyl ether described on page 9, lines 10-11.

The species are independent or distinct because the myriad species within the epoxy and elastomer components of the epoxy/elastomer adduct, epoxy resins, curing agents and the numerous permutations with and without the blowing agent, fillers, catalysts and reactive diluents require various burdensome searches within classes 521, 523 and 525.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-23 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. (MPEP § 809.02(a)).

A telephone call was made to Scott A. Chapple on March 23, 2006 to request an oral election to the above restriction and election of species requirements, but did not result in elections being made. The reply to this requirement to be complete must include (i) an election of species and invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention and species.

The election of an invention and species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions and species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions and species to be obvious variants or clearly admit on the record that this is the case. In either instance, if one of the inventions is found to be unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Upon the cancellation of claims to non-elected inventions, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The Information Disclosure Statement filed June 21, 2004 has been considered as indicated by the attached initialed Form PTO-1449 except for the Fitzgerald patent listed on page 4, the second item which is the wrong patent number. The references cited on the attached Form PTO-892, Notice of References Cited have been culled from the exhaustive list and will be duly considered upon the submission of the response to the restriction and election of species requirement outlined hereinabove.

6. The inventors have been searched for the consideration of any (obviousness-type) double patenting issues. Copending application no. 11/188,010 as represented by U.S. Publication No. 2006/0020076 contains claim 2 denoting an epoxy resin, an epoxy/elastomer adduct, a rheology modifier, a curing agent and a filler.

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7. The specification on page 7, lines 24-25 states that "[i]t is contemplated that the elastomeric component may be only slightly non-reactive with the epoxy component during mixing," thereby indicating the presence of at least a partial reactivity as discussed in the ensuing preferred aspect in lines 25-28. It is unclear how many of the species of elastomers listed on page 3, lines 24-30 can be at least partially reactive with the epoxy component to form the adduct in the absence of any disclosed epoxy-reactive functional groups.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers  
Primary Examiner  
Art Unit 1712